

REMARKS

Claims 1-19 were pending in this application.

Claims 1, 2, 4-8, 10-15, and 17-19 are rejected.

Claims 3, 9, and 16 are objected to.

Claim 1 has been amended, as shown above. Because this amendment does not alter the scope of Claim 1 and places Claim 1 in better condition for allowance or appeal, this amendment complies with 37 C.F.R. § 1.116.

Claims 1-19 remain pending in the application.

I. ALLOWABLE CLAIMS

The Applicant thanks the Examiner for the indication that Claims 3, 9, and 16 would be allowable if rewritten in independent form to incorporate the elements of their base claims and any intervening claims. Because the Applicant believes that the remaining claims are patentable, the Applicant has not rewritten Claims 3, 9, and 16 in independent form.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 7, 13, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,500,538 by Yamazaki et al. ("*Yamazaki*") and U.S. Patent No. 5,589,960 by Chiba et al. ("*Chiba*") in view of U.S. Patent No. 6,310,598 by Koyama et al. ("*Koyama*"). The Office Action rejects Claims 2, 4, 8, 10, 15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Yamazaki*, *Chiba*, and *Koyama* in further view of U.S. Patent No. 6,412,977 by Black et al. ("*Black*"). The Office Action rejects Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Yamazaki*, *Chiba*, and *Koyama* in further view of U.S. Patent No.

4,298,866 by Hodemaekers (“*Hodemaekers*”). The Office Action rejects Claims 6, 11, and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Yamazaki*, *Chiba*, and *Koyama* in further view of U.S. Patent No. 5,940,184 by Okabe (“*Okabe*”). The Office Action rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Yamazaki*, *Chiba*, and *Koyama* in further view of U.S. Patent No. 6,466,204 by Oh (“*Oh*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Regarding Claims 1, 7, and 14, the Office Action acknowledges that *Yamazaki* and *Chiba* both fail to disclose a “measuring element” that is “positioned between” two substrates as recited in the claims. (*Office Action, Page 3*). The Office Action then asserts that *Koyama* discloses these elements of the claims and that it would be obvious to combine *Koyama* with *Yamazaki* and *Chiba*. (*Office Action, Page 3*).

Koyama recites a display device that includes a pixel matrix, a signal line drive circuit, and a scanning line drive circuit. (*Abstract*). The pixel matrix includes thin-film resistors or other switching elements arranged in a matrix, and individual thin-film resistors are controlled using signals produced by the two line drive circuits. (*Col. 1, Lines 16-25*). The display device also includes one or more threshold value control circuits. (*Figures 1 and 12*). The threshold value control circuits control the signals produced by the line drive circuits. (*Abstract*). In this way, the threshold value control circuits can control the operation of the display device.

Koyama simply recites a display device that alters the signals provided to thin-film resistors or other switching elements. *Koyama* lacks any mention of using a “measuring element” that is “positioned between” two substrates as recited in Claims 1, 7, and 14. As a result, *Koyama* fails to disclose, teach, or suggest these elements of Claims 1, 7, and 14.

The Office Action asserts that *Koyama* discloses the use of a “measuring element” that is “positioned between” two substrates at column 1, lines 64-67 and column 2, lines 1-4. (*Office*

Action, Page 3). However, the cited portion of *Koyama* simply states that a previous “active matrix type liquid-crystal display unit” uses thin-film transistors made of polysilicon. (*Col. 1, Lines 64-66*). The cited portion of *Koyama* also states that in this previous unit, a signal line drive circuit and a scanning line drive circuit were formed on “a glass substrate” along with the pixel matrix. (*Col. 1, Line 67 – Col. 2, Line 3*).

This portion of *Koyama* contains no mention of a “measuring element” that is “positioned between” two substrates. In fact, this portion of *Koyama* lacks any mention of a “measuring element” and any mention of more than one substrate. As a result, this portion of *Koyama* fails to disclose, teach, or suggest a “measuring element” that is “positioned between” two substrates as recited in Claims 1, 7, and 14.

For these reasons, the Office Action fails to show that the proposed *Yamazaki-Chiba-Koyama* combination discloses, teaches, or suggests all elements of Claims 1, 7, and 14. As a result, the Office Action fails to establish a *prima facie* case of obviousness against Claims 1, 7, and 14 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection and full allowance of Claims 1-19.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

No fees are believed to be necessary. However, in the event that any fees are required for the prosecution of this application, please charge any necessary fees to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for this extension to Deposit Account No. 50-0208.

Respectfully submitted,

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